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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Alan Kyle Bozeman

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49358

7590

08/03/2006

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EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,736

Applicant(s)

BOZEMAN, ALAN KYLE

Examiner

M. A. Sager

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Reconsideration of Allowability

1. The indicated allowability of claimed subject matter of claims 29-41, 47-48 and 51-53 is withdrawn in view of the reconsideration of claim scope and in view of reference(s) to Koza, Casa, Guttin and Roberts. Rejections based on the newly cited reference(s) follow.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the particular play slip or lottery ticket or printer, each as claimed, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because changes presented amendment received May 3, 2004.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

4. The amendment filed 5/3/04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material that is not supported by the original disclosure is as follows: a pre-printed section listing a pre-printed play phrase (clm 35) appears to be new matter when taken in conjunction with receiving an alphabetical play phrase from a user (clm 29) at least since if the phrase is received from user it cannot be pre-printed (temporal disparity). The specification (including para. 81 cited by Applicants) supports player selection but not the ticket includes a pre-printed section for the play phrase (timing) as claimed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. Claims 35-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Essentially, as best understood, the pre-printed section listing a pre-printed play phrase (clm 35) appears to be new matter when taken in conjunction with receiving an alphabetical play phrase from a user (clm 29) at least since if the phrase is received from user it does not appear to be pre-printed. Essentially, the timing of 'pre-printed' is not taught in concert with player selection of play phrase in manner claimed.

6. Claims 35-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to how the pre-printed section listing a pre-printed play phrase (clm 35) is pre-printed when an alphabetical play phrase is received from a user (clm 29) at least since if the phrase is received phrase from user it is unclear as to how it is pre-printed, i.e. timing issue (supra).

Claim Rejections - 35 USC § 102

7. Claims 29-30, 32-33 and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Koza (5112050). Response to Applicant's remarks is provided below and incorporated herein. With respect to claim interpretation for clarification of record, the language 'alphabetical play phrase' (and similar terminology) includes any text or a word, a sentence or a phrase as per Applicants specification (paragraph 57, 62, 78, 85) that although includes listing as Applicant

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asserts in remarks rec'd Mar 17, 2006 that the play phrase is quotes, film titles, fortune cookies or even simple list of words fitting a theme as cited from specification (paragraph 81) the language is broader and includes any text at least since that although Applicant may be their own lexicographer, in this instance, Applicant did not provide a clear definition (paragraph 31) and the examples cited in the listing (para 81) are merely examples. Thus, the specification permits letters, alphanumeric, numbers, symbols as characters and that any text can form the play phrase (sic). Thus, the broadest reasonable interpretation of the claimed invention with respect to 'alphabetic play phrase' (or similar language) includes a word, a phrase, a sentence or any text. A single word can form a phrase or sentence such as but not limited to GO, NO, STOP, HALT, or similar text or word or phrase, as broadly claimed. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, where alphabetical play phrase includes a word, a phrase, a sentence or any text (sic), Koza discloses an apparatus for playing a word (or letters) based lottery game (2:51-3:20, 3:64-4:4, 4:13-5:28, 6:9-12, 6:21-39, 11:28-68, 12:36-13:35) teaching claimed features or steps, as broadly claimed,

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where the play phrase is selected from a text list comprising a game input unit (6:9-29, 11:36-38, 11:60-68, 12:46-63), a wager input device (11:38-40), a controller operatively coupled to game input and wager input (11:28-13:2, fig. 1-6), the controller generating a random character string and assigning a prize value to the alphabetical play phrase (3:10-20, 5:26-28, 7:25-66, 8:4-11), and determining a payout value based upon the correlation among the character string, the play phrase, the prize value and the wager (3:10-20, 4:51-54, 5:24-28, 6:32-39, 7:25-66, 8:4-11, 11:28-13:2), further including receiving an alphabetical play phrase from a user (11:36-38, 12:36-63), receiving a wager such as acquiring the ticket (4:4, 5:10-12, 11:40), generating a random character string (5:26-28, 6:29-32, 12:36-13:2), determining a correlation among the alphabetical play phrase, the random character string and the wager (*supra*), determining a payout value based upon, at least, the correlation (*sic*). Further, regarding determining a payout value, Koza provides a payout value based upon a correlation among the character string, the alphabetical play phrase, the prize value and the wager as a matching of letter grouping (*sic*). It is noted that Applicants' instant specification includes determining a payout value based upon matching letter group or grouping (paragraph 69 and 77) that is one form of determining a payout encompassed by claim language in a similar manner taught by Koza.

8. Claims 29-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Guttin (6241246). While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were

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found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, where play phrase (or similar language) is any text, Guttin discloses a lottery ticket (figs. 1-5, refs. 4, 6, 8) having a pre-printed section listing a pre-printed play phrase [such as text, sic] comprised of a plurality of words and a random character string having a cover being selectively removable to reveal random character string, whereby a prize (ref. 8) is associated with each word, wherein a prize is won, as broadly claimed. Also, Guttin discloses an apparatus for playing a word based lottery game comprising game input unit (4:60-5:11, 6:36-45, figs. 1-2), wager input device (6:36-49, or inherent to pay to play), a controller generating random character string and determining payout value (6:36-49), phrase is selected by user from menu (figs. 1-2), a ticket printer generating lottery ticket (inherent in that Guttins ticket being generated by a printer, per MPEP 2131.01, see Roberts, figs. Ref. 19), play phrase is received through play slip (sic), first section and selection section or a section listing play phrase and a covered section (refs. 4, 6), where play phrase being same as alphabetical play phrase is a match (ref. 8), covered section can be removed to reveal character string (sic), play phrase comprised of a plurality of words and a prize is associated with each word (figs. 1-2), prize associated with each word may be changed (addition of double/triple bonus, 6:4-13, figs. 3-5), if random string matches a word in play phrase, the user wins a prize associated with word (ref. 8), while if random character string contains all letters of a word in play phrase, the user wins prize associated with the word (ref. 8).

Claim Rejections - 35 USC § 103

9. Claims 34-37 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza (5112050) in view of Roberts (5772510). Discussion above regarding breadth of claim language is incorporated herein. As best understood, where pre-printed phrase is player selected phrase, Koza discloses a word based lottery game comprising claimed steps/features (supra) including a lottery ticket having a pre-printed section listing a pre-printed phrase (11:60-12:11, 12:55-63, 13:26-35), including the play phrase being same as the alphabetical play phrase (12:59-60), prize is associated with each word in the phrase (supra) except a printer generating a lottery ticket (clm 34), a covered section including the random character string (clm 35, 46) and the covered section can be removed to reveal the random character string (clm 37). Lottery tickets having a covered section including the random character string that can be removed to reveal the character string and a printer generating such a lottery ticket by OFFICIAL NOTICE are notoriously well known (i.e. conventional) such as used in pull tab or scratch off games. Roberts (abstract, 1:58-3:4, 4:14, 22-46, figs. 1-8B, ref 19) discloses a lottery ticket and system having a printer (ref. 19) generating a lottery ticket (ref. 12) having a section listing player picks (3:42-5:2) and a covered section having the random character string (Figs 2A-2B, ref 29) for increasing security by completing printing lottery ticket only after sale. Therefore, it would have been obvious to an artisan at a time prior to the invention to add a printer generating a lottery ticket where the lottery ticket also includes a covered section including the random character string as known in predetermined lottery games or as taught by Roberts to Koza to increase security by only completing the printing of the lottery ticket after purchase (3:1-4).

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10. Claims 38-39 and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koza (5112050) in view of Roberts (5772510) as applied to claims 35 above, and further in view of Guttin (6241246). As best understood, Koza in view of Roberts discloses claimed steps/features (supra) but lacks a plurality of words. Further, regarding a plurality of words, with broadest reasonable interpretation of claim language with consideration of lottery schemes, increasing the number of words as the play phrase essentially is increasing number of indicia to match. Thus, although Koza (in view of Roberts) discloses selection of a word from a text listing and includes alphanumeric indicia (12:46-13:2) with or without repeat picks, increasing the number of words in the phrase such that there is a 'plurality of words' fails to patentably distinguish at least due to increasing number of indicia or characters to match is inherent/known in chance games for altering odds by game operators such as exemplified in differences between various lotto/lottery games like pick-3/pick-4 or pick-6 or keno (pick twenty out of 80 digits and match ten or some partial of ten selected to win prize) or bingo that includes indicia matching and also includes order or location requirement. Similarly, increasing number of words to match as claimed such that the lottery includes a plurality of words increases odds over selection of a single word taught by Koza (in view of Roberts) and similarly increases payoff according to game operator desires/design for profitability and to attract interest from players. Also, players are attracted to large prize values and by increasing difficulty of game by decreasing probability for a player to obtain all elements (increased number of indicia to match decreases probability of success which increases payout resultant from less likelihood of success, e.g. keno versus pick-3) results in larger prizes that increases player interest to play and increases profits for game operator from the increased play. In addition to inherent teachings between various games of

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chance of lottery, bingo and keno, Guttin (6:26-41, figs 1-2) or Casa (4:4:60-67, 6:1-15) is each provided as evidence under MPEP 2131.01 of such altering odds by increasing characters/indicia or words with subsequent change to payout. Alternatively, Guttin discloses a lottery ticket for a word game teaching a play phrase comprised of a plurality of words (sic). Thus, it would have been obvious to an artisan at a time prior to the invention to add plurality of words as known/inherent in games of chance such as lottery, keno or bingo as evidence by either Casa or Guttin, or as taught by Guttin to Koza in view of Roberts so that game operator/designer can increase attraction to players by increasing payout which due to increased play by players (due to the increase in payout) profitability of game increases. Further, altering prize structure of a game of chance is under game operator control to ensure attraction of game to players while maintaining profitability. Alternatively, a player alters prize payout based in part on wager or Guttin discloses altering payout (figs. 3-5) as a bonus amount such as double.

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koza in view of Casa (5613679) or Guttin (6241246). Koza discloses an apparatus for playing a word based lottery game teaching claimed features/steps (supra) including a lottery play slip (11:64-68, 12:46-13:2, 13:26-35) and a selection section allowing alphabetical play phrase to be coded (12:46-13:2 and 26-35, or as evidence for inherency under MPEP 2131.01 see Casa, 4:47-67, 5:1-6:17, figs. 1-3 or see Guttin, figs. 1-2, refs 4, 6) except a first section containing the alphabetical play phrase. Koza relies upon conventional play slip format for reading input (11:64-68, 12:46-13:2, 26-35) and as such does not further disclose details of a conventional lottery play slip, thus any conventional play slip may be used. Alternatively, Koza discloses use of lottery play slip or at least permits other lottery schemes and techniques but lacks detailing

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format of play slip to include a first section and a selection section. Casa discloses a method of playing a lottery game teaching a conventional play slip having a selection section to allow the string to be coded by player. Regarding the first section, it is notoriously well known (by OFFICIAL NOTICE) in testing art to permit user input via hand written input in conjunction with a selection section to be user coded of the written input where the hand written input allows quick visual verification of hand written input to ensure intended player/user response of player coded input while the coding allows machine reading. Thus, it would have been obvious to an artisan at a time prior to the invention to add a first section containing the play phrase, as notoriously well known and a selection section as conventional or as taught by Casa to Koza to utilize known play slip format thereby saving development costs and for ease of play by players due to familiarity of game format and to permit quick visual verification of coded input.

Alternatively, Guttin further discloses a lottery ticket for a word game teaching a first section containing the play phrase and a selection section allowing the play phrase to be coded (supra). Thus, it would have been obvious to an artisan at a time prior to the invention to add a first section containing the play phrase or a selection section allowing the play phrase to be coded as taught by Guttin to Koza for increased player enjoyment and to reduce development cost by using known lottery scheme.

Response to Arguments

12. Applicant's arguments with respect to claims 42-46 and 49-50 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments filed March 17, 2006 have been fully considered but they are not persuasive. Regarding Applicants assertion that paragraph 81 of originally filed specification

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supports pre-printed section of lottery ticket, the examiner respectfully disagrees. The specification including cited paragraph 81 in particular lacks teaching the temporal distinction of receiving an alphabetical play phrase from user when there is a pre-printed section (*supra*).

Further, regarding Applicants remark that phrases are neither a long series of letter characters nor a plurality of words, the examiner respectfully disagrees. Although the applicant may be their own lexicographer, in this instance, Applicants opted not to be their own lexicographer and did not provide a definition for play phrase contrary to the example cited by Applicant from paragraph 81. The specification and claims includes that the play phrase includes a plurality of words and specification further allows play phrase as a series of letter characters at least due to any text (paraphrased 57, 62, 78, 85). Regarding Applicants remark that Koza does not disclose receiving an alphabetic play phrase from a user of claim 42 (and 46 and 49), the examiner disagrees. Koza clearly teaches receiving a play phrase as a word from a text listing and where in instances that user selected word is also a phrase or sentence (i.e. not an exhaustive listing, but clearly may include STOP, GO, LOOK, HALT, SEEK, etc.), breadth of claimed invention fails to preclude Koza. Regarding play slip of claim 43, the prior action on page 5 therein provided citation within Koza where play slip is taught (11:60-68). One of ordinary skill in the art, upon a reading of Koza would interpret supplying game values via a lottery ticket (11:64-68) as being a play slip for purposes of reading in game values. However, one of ordinary skill in the art may also consider in conjunction with player selects a word [aka phrase] from a list of preselected words (12:46-13:2) and various additional lottery schemes and techniques (13:26-35) as further support for lottery slip. Regarding plurality of phrases or plurality of words (claim 49), Koza includes a list of a plurality of words for a player to select and the play phrase includes selection

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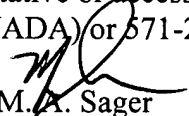
of a word (sic). The number of letters or words or phrases in the random character string or play phrase does not patentably distinguish as discussed in holding above incorporated herein with respect to discussion regarding it being known to increase number of elements to match such as between various chance game schemes (lottery pick-3/pick-4/pick-6, bingo , keno) or as taught by Guttin. Also, Koza's listing of words that are also sentences or phrases (GO, STOP, HALT, SEEK), thus, demonstrate Koza includes a listing of plurality of phrases thereby.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, John Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


M.A. Sager
Primary Examiner
Art Unit 3712

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